

### **REMARKS**

Applicants have carefully reviewed the new ground of rejection issued in Office Action dated May 25, 2004, and respectfully request reconsideration in view of the following remarks. A separate petition and fee to extend the time to respond by three (3) months accompany this response.

The current status of the claims is as follows: Subsequent to Applicants' filing of their Appeal Brief on April 2, 2004, the examiner issued this Office Action to reopen prosecution and enter a new ground of rejection.

In the instant Office Action, claims 1-13 pending in this application now stand rejected under a new ground.

Before discussing the new ground for rejection, Applicants and Applicants' attorney would like to thank the examiner and her Supervisory patent examiner for the courtesies extended during the personal interview held at the Patent Office on August 26, 2004.

In addition, Applicants are pleased that the 35 USC 102(e) rejection over Corrigan et al. has been withdrawn, in light of Applicants' appeal brief.

#### **New Ground of Rejection – 35 USC § 103**

Claims 1-13 now stand rejected under 35 USC 103(a) as being obvious over Corrigan et al (US 6,522,977).

In response to this new ground of rejection, Applicants respectfully disagree with the examiner's position and reconsideration and withdrawal are respectfully requested.

The examiner has applied a hindsight-based obviousness analysis, using the invention as a roadmap, to find that a person of ordinary skill in the art would have been motivated to remove the physical color reading feature from the method described in Corrigan et al. to arrive at the present invention.

The examiner has argued that removing the color spectrometry feature from Corrigan et al to arrive at the claimed invention would have been obvious to one of ordinary skill in the art for one of the following reasons.

In the instant Office Action, the examiner argues:

Corrigan discloses a method that requires both VIN number and scanning sample color in order to obtain an accurate color matching. However, it is possible for one with skill in the art at the time the invention was made to practice different way, such as eliminating the step of scanning the sample color, for some reasons: the result would be the same without scanning the sample color because the VIN number fully provides the color matching; the eliminated step would reduce the cost of the paint job. (Office Action, Page 3)

In the subsequent Interview held on August 26, 2004 both the examiner and her SPE argued the following:

Examiners argued that removing the spectrometry feature from Corrigan would have been obvious because one of ordinary skill in the art would have recognized that there is a large market segment of collision shops that may not be able to afford more expensive Corrigan system as disclosed, but would be able to afford a simplified version of the Corrigan system. (Interview Summary, Page 2)

All of the examiner's reasons for modifying the Corrigan method to arrive at the claimed invention, however, are based on mere speculation and hindsight reasoning. There is no showing, teaching or suggestion in the prior art or in the knowledge generally available to one of skill in the art at the time the invention was made, which supports the examiner's position that one of ordinary skill in the art would have been motivated to make the modification proposed. Furthermore, there is nothing in the prior art that reveals that there would have been any reasonable expectation of success by those of ordinary skill that such a system would work, that is, without the color measurement piece as required in Corrigan et al.

The examiner therefore offers mere conclusions and speculation, yet has not offered a legally sufficient showing, suggestion or teaching which might suffice to support the new rejection. The examiner has not even established, without using hindsight reasoning and Applicants' own disclosure, why a person of ordinary skill in the art would even be looking for an alternative method,

particularly where a method, such as Corrigan, is already known for obtaining a matching refinish paint formulation.

As we argued in the Appeal Brief, there is nothing in Corrigan et al that states that their method can be run without measuring and inputting physical paint color data of the vehicle being repaired. (See Corrigan, fig. 1, elements 12 and 14). Furthermore, there are no teachings or suggestions in Corrigan to motivate one skilled in the art, who has no knowledge of the claimed invention, to make the changes proposed by the examiner to make the claimed invention. If the Examiner knows of a reference or piece of evidence that shows or suggests that such changes could be made and shows there would be a reasonable expectation for success, it should be made part of the rejection. Without such support, the allegation of obviousness is merely unsupported speculation and should be withdrawn


For the forgoing reasons along with the reasons already presented on the record including the arguments submitted with Applicants' appeal brief, the present invention constitutes a significant advancement in the art, not just a simplification over Corrigan's method, and should be deemed patentable.

Reconsideration and withdrawal of the 103 rejection are therefore respectfully requested.

### **Conclusion**

The claims have been previously amended to more clearly point out the invention and the patentable differences between Applicants' invention and the cited art have been further set forth herein. The application should now be in allowable form. If for some reason the application is not allowable, Applicants' attorney request a telephonic interview with the Examiner to discuss the case and any additional amendments to the claims that may be required to place the case in allowable form.

Respectfully submitted,

  
STEVEN C. BENJAMIN  
ATTORNEY FOR APPLICANTS  
REGISTRATION NO. 36,087  
TELEPHONE: (302) 992-2236  
FACSIMILE: (302) 992-2533

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